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Patent
Attorney Docket No. GEMS8081.091

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of	:	Boskamp, Eddy B.
Serial No.	:	10/063,550
Filed	:	May 2, 2002
For	:	Wireless RF Module For An MR Imaging System
Group Art No.	:	3737
Examiner	:	Smith, Ruth S.

CERTIFICATION UNDER 37 CFR 1.8(a) and 1.10

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37 CFR 1.8(a) **37 CFR 1.10**

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RENEWED PETITION UNDER 37 C.F.R. 1.181 REQUESTING WITHDRAWAL OF THE HOLDING OF ABANDONMENT AND REQUESTING WITHDRAWAL OF THE HOLDING OF NON-COMPLIANT APPEAL BRIEF

Dear Sir:

Responsive to the Decision on Petition mailed August 6, 2008, Applicant respectfully requests reconsideration of the request for withdrawal of the holding of abandonment, as well as withdrawal of the holding of non-compliant appeal brief, for the reasons set forth below.

REMARKS

According to the Notice of Abandonment mailed November 21, 2007, the present application was abandoned allegedly for Applicant's failure:

> "to provide an amended brief or other appropriate correction. The proposed amendment to claim 17 was not entered because it raised new issues. The record fails to show that the examiner agreed to enter the proposed changes to claim 17 upon appeal."

Notice of Abandonment, November 21, 2007. On January 17, 2008, Applicant filed a Petition Requesting Withdrawal of the Holding of Abandonment and a Request to Withdraw the Holding of a Non-Compliant Appeal Brief. An August 6, 2008 Decision on Petition (hereinafter "Decision") dismissed this petition, primarily on the grounds that there was allegedly no record of the Examiner's agreement to enter the amendment to claim 17 prior to appeal. However, Applicant strongly disagrees and requests reconsideration of both the Petition Requesting Withdrawal of the Holding of Abandonment and Petition Requesting Withdrawal of the Holding of a Non-Compliant Appeal Brief. The basis is that there actually is a record in the File History and Applicant believes the Office must consider the entire record, not just the half initiated by the Examiner.

Detailed Analysis:

In the Decision, the Director set forth six relevant portions of the record under review. Most notably, the Director submitted the following:

> "A Response to Notification of Non-Compliant Appeal Brief was filed on December 1, 2005. In this response, the applicant asserted that the examiner and the applicant had a telephone conversation and agreed that the August 17, 2005 Amendment After Final Rejection would be entered. However, the record does not show a record of the telephone conversation. No telephone summary form was completed by the examiner. The applicant submitted his record of the telephone conversation after Nov. 2, 2005."

Decision, August 6, 2008, p. 1, (emphasis added). Applicant, however, disagrees with several of the statements made in this section, as they are clearly incorrect. In particular, the record *does* indeed show a record of the August 17, 2005 telephone conversation, submitted with the After-Final Amendment on August 17, 2005. The After-Final Amendment submitted by Applicant detailed a telephone interview between the Examiner and Applicant, wherein the Examiner stated only that the amendments filed by the Applicant in the After-Final Amendment of April 25, 2005 could not be entered because of informalities with respect to claims 5, 19, and 25. *See After Final Amendment*, August 17, 2005, p. 7. Accordingly, Applicant canceled or amended claims 5, 19,

and 25 to address the Examiner's objections in the August 17, 2005 After-Final Amendment. Applicant thus believed that the application, including claim 17, was in better condition for appeal and that the Examiner would enter the proposed amendments as agreed. Nowhere on the record is it shown that the Examiner disagreed with the proposed amendment to claim 17 prior to the Notice of Non-Compliant Appeal Brief mailed November 2, 2005. Clearly, Applicant's Interview Summary (satisfying the requirement of by MPEP §713.04) was indeed submitted (on August 17, 2005), and thus the telephone interview was sufficiently made of-record prior to November 2, 2005.

Additionally, with respect to the Director's statement that no telephone interview summary form (PTOL-413) was completed by the Examiner, Applicant notes that while Applicant submitted its required interview summary, "[i]t is the examiner's responsibility to see that such a record is made and to correct material inaccuracies which bear directly on the question of patentability." *See MPEP* 713.04. As the Examiner did not attempt to correct the record to show that Applicant's statements and amendments set forth in the After Final Amendment of August 17, 2008 were "materially inaccurate," Applicant believes that the record was entirely accurate and that the only claims questioned by the Examiner were claims 5, 19, and 25, *not* claim 17. Further, by failing to complete an Interview Summary form PTOL-413, the Examiner did not comply with Office protocol set forth in MPEP 713.04, which states that "Examiners ***must*** complete an Interview Summary form PTOL-413 for each interview where a matter of substance has been discussed during the interview by checking the appropriate boxes and filling in the blanks." *Id.* Applicant cannot force an Examiner to do their job correctly and therefore, Applicant cannot be punished for the Examiner's failures when the Applicant complies with their obligations. Without an objection by the Examiner on the record or a separate Interview Summary from the Examiner, the record of the telephone interview Applicant submitted on August 17, 2005, the Office must rely upon that which was timely submitted by Applicant, not what the Examiner failed to do in a timely manner. The Office should not punish an Applicant for the Examiner's neglect to follow the regulations as set forth in the MPEP.

Referring now to the Analysis and Discussion section of the Decision, the Director stated that "[t]he Notification of Non-Compliant Appeal Brief of November 2, 2005 indicated the August 17, 2005 amendment introduced the new element of 'UHF carrier frequency signal' to claim 17." *Decision*, supra at 2. Applicant notes that the alleged new element (the "UHF carrier frequency signal)," was introduced into claim 17 in an Amendment After-Final filed April 25, 2005, well before the August 17, 2005 After-Final Amendment. As such, the proposed

amendment to claim 17 was on the record during the August 17, 2005 telephone interview between the Examiner and Applicant, and based on the August 17, 2005 interview summary discussed above, the Examiner only objected to the entry of claims 5, 19, and 25, *not* claim 17. Applicant therefore reasonably believed that the amendment to claim 17 was acceptable and placed the application in better condition for appeal. Again, because the record shows that the Examiner only objected to claims 5, 19, and 25, Applicant reasonably believed, and the record shows, that the August 17, 2005 After-Final Amendment should have been entered and that claim 17 was deemed acceptable by the Examiner at that time, prior to appeal.

Referring again to the Decision, regarding the basis of the petition under 37 CFR 1.181, the Director stated that "the present petition is untimely, as the period to reply to the November 2, 2005 Notification of Non-Compliant Appeal Brief has expired." *Decision*, supra at 3. However, it is noted that Applicant timely submitted a response to the November 2, 2005 notification on December 1, 2005. The December 1, 2005 response set forth arguments similar to those presented herein, namely that the Examiner had agreed to enter the amendment to claim 17 in the August 17, 2005 telephone interview. In view of the arguments presented, Applicant had no reason not to believe that the proposed amendment had been entered and that the Appeal Brief filed August 23, 2005 was then fairly found to be accepted. Not until the Notice of Abandonment was mailed on November 21, 2007 (2 years later) was Applicant made aware that the December 1, 2005 response was insufficient. For the Patent Office to wait more than two years to notify Applicant that the filed response was insufficient is untimely in itself, not to mention detrimental to fair and equitable patent examination. Had Applicant any idea that the December 1, 2005 response was not acceptable, a timely supplemental response or petition would have been filed to remedy any remaining issues pertaining to the Appeal Brief. Instead, Applicant was left waiting for an Examiner's Answer, only to be issued a Notice of Abandonment so far after the required date for response that Applicant is left with little recourse. Based on this record, Applicant's Petition cannot be considered to be "untimely." Throughout this prosecution it is the Applicant who has been timely, and the Office who has acted in an untimely manner. Again, because of Examiner turn-over, Applicant should not bear punishment.

Accordingly, in view of the factual inaccuracies and oversights set forth in the August 6, 2008 Decision on Petition, Applicant requests reconsideration of the Petition for Withdrawal of the Holding of Non-Compliant Appeal Brief, along with reconsideration of the Petition for Withdrawal of the Holding of Abandonment. As set forth above, Applicant believes that the record **clearly** shows evidence of an agreement between the Examiner and Applicant, particularly

with regard to claim 17 and that Applicant, at all times, was indeed timely in its responses. As such, Applicant again requests that the Notice of Abandonment be withdrawn and that the Appeal Brief filed August 23, 2005 be considered compliant. At the very least, the Notice of Abandonment must be withdrawn to allow the most current Examiner and Applicant reach a meeting of the minds as to the status of the claims for appeal.

In order to avoid any further delay, Applicant requests that the Office telephone the undersigned to expedite any unresolved matters with regard to this application.

Respectfully submitted,

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Dated: October 3, 2008
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